

REMARKS

PARAGRAPHS 2 & 3 – THE WRITTEN DESCRIPTION SUPPORTS CLAIM 39.

The Office Action states that claim 39 is rejected under § 112, ¶ 1 because the “subject matter was not described in the specification in such a way as to reasonably convey to one of ordinary skill in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.” After a telephone discussion with Examiner Fischer on September 28, 2001, a discussion Applicant appreciates, Applicant agreed to amend claims 38 and 39, the written specification, and add additional drawings because MPEP § 2163.07a, as suggested by Examiner Fischer, supports these amendments. Applicant asserts that amended claims 38 and 39, the substitute specification, and the additional drawings do not add new matter. Instead, MPEP § 2163.07a (i.e., inherency), at a minimum, supports these above-mentioned amendments, and these same amendments are made to more fully comply with the written description requirement. In sum, Applicant respectfully requests withdrawal of the rejection in light of the “Amendments” section and these “Remarks” to paragraphs 2 and 3 of the Office Action.

PARAGRAPHS 4 & 5A– DEFINITENESS IS SUPPLIED FOR CLAIMS 37-58.

The Office Action states that claims 37-58 are rejected under § 112, ¶ 2 because “In claim 37, it is still unclear whether the applicant is claiming the subcombination or a device or the combination of the device and a storage compartment.” Applicant disagrees that claims 37-58 are indefinite. Below, Applicant provides argument for this traversal.

Applicant’s amendments to independent claim 37 clearly define a device for use with a storage compartment for a vehicle, e.g., a pick-up truck. That is, Applicant is claiming the subcombination.

1 Applicant agrees that "for use with a storage compartment for a vehicle having a
2 receptacle and for use with a trailer hitch mounting apparatus, the mounting apparatus having
3 a male trailer hitch mounting member" are functional limitations and that functional
4 limitations are entitled to at least some patentable weight.¹ Applicant disagrees that these
5 functional limitations in the preamble are outside the claim's scope.

6 The functional language in Applicant's preamble should be given patentable weight
7 because "terms appearing in a preamble may be deemed limitations of a claim when they
8 'give meaning to the claim and properly define the invention.'"² Moreover, "review of a
9 patent in its entirety should be made to determine whether the inventor[s] intended such
10 language to represent an additional structural limitation or merely introductory language."³

11 Upon review of amended claim 37 and the specification, it is clear that the Applicant was
12 working on a specific problem: storage of trailer hitch mounting apparatus onto walls,
13 regardless whether those walls were in a garage, in a dwelling, in a storage warehouse, on a
14 vehicle storage compartment, or in a vehicle storage compartment.⁴ As a result, Applicant's
15 claim 37 preamble does not merely state a purpose or intended use for the claimed structure.

16 Rather, as the application reveals, Applicant intends to and does claim a device for storing a
17 trailer hitch mounting apparatus in and on a vehicle storage compartment. Accordingly, the
18 functional language in claim 37's preamble provides "life and meaning" to claims 37-57, and
19 therefore is the functional language is a limitation entitled to at least some patentable weight.⁵

20 Finally, Applicant respectfully notes that the indefiniteness rejection pertained to
21 independent claim 37. Accordingly, then if this indefiniteness rejection is withdrawn, then all

¹ Office Action, paragraph 5a; Applicant's claim 37.

² *In re Paulson*, 30 F.3d 1475, 1479 (Fed. Cir. 1994).

³ *Id.*; *Corning Glass Works v. Sumitomo Elec. U.S.A., Inc.*, 868 F.2d 1251, 1257 (Fed. Cir. 1989)(inventors working on a particular problem; functional language in preamble given patentable weight.)

⁴ Applicant's specification, pp. 6, 7, and 9.

⁵ *Corning Glass*, 868 F.2d at 1257;

claims dependent from claim 37 will also be considered definite.⁶ Applicant respectfully requests reconsideration and withdrawal of the indefiniteness rejections issued against claim 37 and its dependent claims.

PARAGRAPHS 4 & 5B- AMENDMENT RENDERS CLAIM 39 DEFINITE.

The Office Action states that claim 39 is rejected because it is unclear how a block may be positioned through all of the receptacle. As stated in the "Amendments to the Specification" and "Additional Drawings" sections above, claim 39 was amended after a telephone conversation with Examiner Fischer on September 29, 2001. Based on this telephone discussion, Applicant believes that Examiner Fischer and Applicant are in agreement that explicit support now exists for amended claim 39, wherein the explicit support was founded on the original specification, i.e., no new matter was added to the original application. As a result, Applicant respectfully requests entry of amended claim 39.

PARAGRAPHS 6, 7 & 8- NO ANTICIPATION BY KLEMETSEN.

Claims 1-7, 9, 10, 47-43 and 45-56 stand rejected under § 102(b) as being anticipated by United States Patent 5,476,279 issued to Klemetsen ("the Klemetsen patent"). Applicant respectfully disagrees and submits the following discussion for the traversal, and shows that Applicant's invention is novel in light of the Klemetsen patent. Below, Applicant provides argument for this traversal.

For a claim to be anticipated, the prior art must describe each element and limitation of that claim.⁷ Further, the prior art "must also enable one of skill in the art to make and use the

⁶ *In re Fine*, 837 F.2d 1071, 1076 (Fed. Cir. 1988).

⁷ *C.R. Bard, Inc. v. M3 Systems, Inc.*, 157 F.3d 1340, 1349 (Fed. Cir. 1998); *Celeritas Techs. Ltd. v. Rockwell Intl. Corp.*, 150 F.3d 1354, 1360 (Fed. Cir. 1998).

claimed invention.”⁸ (Henceforth, Applicant collectively refers to these two prior sentences as “the test”, wherein the first sentence is referred to as “prong 1” and the second sentence is referred to as “prong 2”). Using the test, Applicant shows below that none of Applicant’s claims are anticipated by the cited prior art, i.e., the Klemetsen patent.

Klemetsen does not anticipate amended independent claim 1 or amended independent claim 37, and their respective dependent claims, because Klemetsen does not claim “a mounting portion”, “a mounting portion connected to the predetermined storage location, wherein the predetermined storage location comprises a wall” or “a mounting portion connected to a storage compartment surface, wherein the surface is selected from the group consisting of a wall and a bottom.” – also referred to as “the missing descriptive matter.” Therefore, Klemetsen fails prong 1, and does not anticipate Applicant’s invention. Applicant, however, continues to refute the Klemetsen anticipation rejection on more grounds.

Inherency does not provide the missing elements and limitations for Klemetsen to anticipate Applicant’s invention. To establish inherency, the “evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.”⁹ Contrary to Applicant’s amended claims 1 and 37, the Klemetsen patent does not explicitly or inherently reveal “the missing descriptive matter.”

To support its anticipation by inherency argument, the Office Action compares “the structural frame” of the Klemetsen patent to Applicant’s “mounting portion.” Unlike Applicant’s mounting portion, the Klemetsen patent only reveals “the structural frame” as having a means for attachment to a vehicle or storing tow hitches. Besides possible attachment to a vehicle, the Klemetsen patent never mentions or claims attachment of “the structural frame”

⁸ *Bristol-Myers Squibb Co. v. Ben Venue Laboratories, Inc.*, 246 F.3d 1368, 1374 (Fed. Cir. 2001)(quoting *In re*

to a substrate or a means for connection of “the structural frame” to a wall or to a storage compartment. Accordingly, the Office Action does not clearly show that “the missing descriptive matter” is necessarily present in the Klemetsen patent, and moreover, does not show that it would be so recognized by persons of ordinary skill. In fact, “the structural frame” containing mounting cylinders and mounted to a wall is merely a possibility, and therefore, not the proper basis for anticipation by inherency.”¹⁰ Accordingly, even inherency does not support anticipation of Applicant’s amended and independent claims 1 and 37, and their respective dependent claims, which are also not anticipated because of their dependency.¹¹

On an additional note, but a subject matter previously addressed under the “Paragraph 4 & 5a” section, amended independent claims 1 and 37 contain functional language that breathes life and meaning into the claims, and therefore, the functional language should be afforded at least some patentable weight.¹² That is, the functional language is incorporated into the claims as claim limitations because, as the specification reveals, amended independent claims 1 and 37 solve a particular problem: storage of trailer hitch mounting apparatuses on walls, and in/on storage compartments. Accordingly, for all the reasons above, Applicant respectfully requests reconsideration and withdrawal of all the anticipation rejections.

PARAGRAPH 9– APPLICANT INVOKES “MEANS FOR”.

Applicant believes that claims 29-36 do invoke “means for” as under § 112, ¶6.

PARAGRAPH 10-12 – APPLICANT INVENTION IS NOT OBVIOUS.

The Office Action states that claims 11-20 and claims 47-56 are rejected as unpatentable over the Klemetsen patent. Applicant respectfully disagrees and submits the following

Donohue, 766 F.2d 531, 533 (Fed. Cir. 1985)).

⁹ *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999).

¹⁰ *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999).

¹¹ *In re Fine*, 837 F.2d 1071, 1076 (Fed. Cir. 1988).

discussion for the traversal, and shows that Applicant's invention is nonobvious in light of the Klemetsen patent. Below, Applicant provides argument for this traversal.

The *prima facie* case of obviousness requires: 1) some suggestion or motivation in references or in knowledge of those skilled in the art to modify a reference, 2) that references possess a reasonable expectation of success in the modification or combination, **and** 3) that references must teach or suggest all of Applicants' claim elements and limitations (emphasis added).¹³ In addition to the rule, *prima facie* obviousness is to be determined according to whether the claimed invention as a whole would have been obvious, and not whether the differences between the prior art and the claimed invention would have been obvious.¹⁴ Still more, the *prima facie* case is not to be founded on hindsight, or as the court said in *W. L. Gore & Assocs., Inc. v. Garlock, Inc.*, "to imbue one of ordinary skill in the art with knowledge of the Applicant's invention, when the prior art does not teach or suggest the relevant knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher," i.e., the inventor.¹⁵

Under the first prong, Applicant asserts that no suggestion or motivation exists in the Klemetsen patent to render obvious Applicant's claims 11-20 and claims 47-56. In paragraph 34 of the Office Action, the Office Action tacitly admits that Klemetsen does not contain "an express suggestion to achieve the claimed invention." Instead, in paragraphs 35-36, the Office Action takes the position that an "implicit suggestion" from "the prior art as a whole" (which also includes Klemetsen, Francisco, Howell) disclose(s) the motivation." Applicant respectfully asserts that reliance on an *implicit* motivation found in *the prior art as a whole* in view of the Klemetsen patent is so tenuous as to amount to a failure to show the first prong of the obviousness test.

¹² *Corning Glass*, 868 F.2d at 1257;

¹³ MPEP § 2142; *In re Vaeck*, 947 F.2d 488, 493 (Fed. Cir. 1991); *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986); *In re Royka*, 490 F.2d 981, 985 (C.C.P.A. 1974).

¹⁴ *In re Napier*, 55 F.3d 610, 613 (Fed. Cir. 1995); MPEP 2141.02.

“When determining the patentability of a claimed invention which combines two known elements, ‘the question is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination.’”¹⁶ There is no suggestion in the prior art for a desirability to have an invention that claims a mounting portion connected to a wall or a storage compartment. Even if use of cylinders are within the knowledge of one of ordinary skill, no suggestion or motivation exists that shows modification of the Klemetsen patented invention would be an obvious endeavor. If Applicant’s invention were *so* obvious, then Klemetsen and/or others would or should have disclosed Applicant’s invention.

In addition, Applicant believes that the Office Action’s position of an implicit suggestion in view of the prior art as a whole and Klemetsen is so broad a rejection as to be indefensible. Instead of founding a basis for a rejection under prong 1 of the obviousness test, Applicant asserts that the Office Action’s rejection is impermissibly founded on hindsight because the Office Action “does not show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed.”¹⁷ Accordingly, Applicant asserts that the Klemetsen in view of all the prior art does not render obvious Applicant’s claims 11-20 and 47-56, not only because these dependent claims are non-obvious in their own right, but because their respective independent claims are also non-obvious under prong 1, and therefore, claims 11-20 and 47-56 stand or fall with their respective independent claims.¹⁸

In addition to the foregoing, Applicant asserts that Applicant did traverse the Official Notice contrary to paragraph 12 of the Office Action. In response to the Office Action mailed March 14, 2001, Applicant states on page 2 under the heading of “Response to the Office Action” that “Applicant responds with traverse to the Office Action. Reconsideration of the above-identified

¹⁵ *W. L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553 (Fed. Cir. 1983).

¹⁶ *WMS Gaming, Inc. v. Int’l Game Tech.*, 184 F.2d 1339, 1355 (Fed. Cir. 1999) (quoting *In re Rouffet*, 149 F.3d 1350, 1356 (Fed. Cir. 1998)).

¹⁷ *In re Rouffet*, 149 F.3d at 1357.

case is respectfully requested in view of the following response.” Applicant asserts that this statement of traversal and the argument/reasons for traversal found in that response are sufficient to show that Applicant did not ever agree with any grounds of rejection found in the Office Action mailed March 14, 2001. In addition, the Conclusion section on page 26 of the Office Action mailed March 14, 2001 states “Applicant proposes that Klemetsen, . . . official notice, . . . alone or in combination, does not render the claimed invention obvious.” In sum, Applicant asserts that Applicant did traverse the Official Notice found in the Office Action mailed March 14, 2001, contrary to the instant Office Action. Applicant respectfully requests reconsideration and withdrawal of this holding of admission.

In addition to failing the first prong, Applicant asserts that Klemetsen in view of the prior art as a whole fail the third prong: teaching or suggesting all of Applicants’ claim elements and limitations. As stated previously, Klemetsen does not teach a mounting portion, a mounting portion connected to a wall, a mounting portion connected to a storage compartment, cylinders, and more. As for teachings of the prior art as a whole, such a combination is unknown because this breadth of this combination is immense. Applicant believes, however, that no prior art teaches or suggests a mounting portion connected to a wall, and thereby, earnestly asserts that Klemetsen in view of all prior art also fails the third prong of the obviousness test. As a result, Applicant asserts that the Klemetsen in view of all the prior art does not render obvious Applicant’s claims 11-20 and 47-56, not only because these dependent claims are non-obvious in their own right, but because their respect independent claims are also non-obvious under prong 3, and therefore, claims 11-20 and 47-56 stand or fall with their respective independent claims.¹⁹

¹⁸ *In re Fine*, 837 F.2d 1071, 1076 (Fed. Cir. 1988).

PARAGRAPH 10, 13– APPLICANT INVENTION IS NOT OBVIOUS.

The Office Action states that claims 8 and 44 are rejected as obvious, and therefore unpatentable over Klemetsen in view of Francisco. Applicant respectfully disagrees and submits the following discussion for the traversal, and shows that Applicant's invention is nonobvious over Klemetsen in view of Francisco. Below, Applicant provides argument for this traversal.

Using the same obviousness test used under "Paragraph 10, 11" above, Klemetsen in view of Francisco fails prong 1 because neither reference provides suggestion or motivation, and there is no indication such a suggestion or motivation, as suggested by the Office Action at paragraph 13, would occur to one of ordinary skill in view of Klemetsen and Francisco, to render obvious Applicant's claims 8 and 44. In addition to failing prong 1, Applicant further asserts that Klemetsen and Francisco fail prong 3 because neither alone or in combination do these references teach or suggest all the elements of Applicant's invention as found in claims 8 and 44. More specifically, under prongs 1 and 3 of the obviousness test, nowhere is it suggested, and nowhere is there a motivation, for anyone, to construct a device, method or system that includes a mounting apparatus for attaching to a wall.

Applicant agrees the Office Action that Klemetsen does not directly disclose a mounting portion being pivotally attached, but disagrees that a pivotal attachment for that allows the vehicle and trailer to be further apart during hitching is amounts to a teaching, motivation or suggestion that renders obvious Applicant's dependent claims 8 and 44. In short, Applicant asserts that the Klemetsen in view of Francisco and one of ordinary skill in the art does not render obvious Applicant's claims 8 and 44, not only because these dependent claims are non-obvious in their own right, but because their respect independent claims are also non-obvious

¹⁹ *In re Fine*, 837 F.2d 1071, 1076 (Fed. Cir. 1988).

under prongs 1 and 3, and therefore, claims 8 and 44 stand or fall with their respective independent claims.²⁰

PARAGRAPH 10, 14 – APPLICANT INVENTION IS NOT OBVIOUS.

The Office Action states that claims 21-36 and are rejected as unpatentable over the Klemetsen patent and Applicant's admission that "inventions are not patentably distinct." Applicant asserts that claims 21-36 are not patentably distinct, believes this rejection to be erroneous, and therefore, respectfully requests reconsideration and withdrawal of this rejection.

PARAGRAPH 10, 15, 16 – APPLICANT INVENTION IS NOT OBVIOUS.

The Office Action states that claims 57 and 58 are rejected as unpatentable over Klemetsen in view of Howell. Because Applicant canceled claim 58, Applicant only addresses the rejections issued against claim 57. Applicant respectfully disagrees and submits the following discussion for the traversal, and shows that Applicant's invention is nonobvious in light of the Klemetsen in view of Howell. Below, Applicant provides argument for this traversal.

Using the same obviousness test used under "Paragraph 10, 11" above, Klemetsen in view of Howell fails prong 1 because neither reference provides suggestion or motivation, and there is no indication such a suggestion or motivation, as suggested by the Office Action at paragraph 13, would occur to one of ordinary skill in view of Klemetsen and Howell, to render obvious Applicant's claim 57. In addition to failing prong 1, Applicant further asserts that Klemetsen and Howell fail prong 3 because neither alone or in combination do these references teach or suggest all the elements of Applicant's invention as found in claim 57. More specifically, under prongs 1 and 3 of the obviousness test, nowhere is it suggested, and nowhere is there a motivation, for anyone, to construct a device, method or system that includes a mounting

²⁰ *In re Fine*, 837 F.2d 1071, 1076 (Fed. Cir. 1988).

apparatus for attaching to a wall. Applicant indeed cannot find any basis why it would have been obvious for one of ordinary skill to combine Howell with Klemetsen. Similarly, Applicant cannot find any basis to support the Office Action's Official Notice regarding that pick-up trucks have storage compartments and a suggestion to combine or a motivation exists that one of ordinary skill would recognize to render obvious Applicant's claim 57.

In short, Applicant asserts that the Klemetsen in view of Francisco and one of ordinary skill in the art does not render obvious Applicant's claims 8 and 44, not only because these dependent claims are non-obvious in their own right, but because their respective independent claims are also non-obvious under prongs 1 and 3, and therefore, claims 8 and 44 stand or fall with their respective independent claims.²¹

CONCLUSION

For the foregoing reasons, Applicant respectfully requests reconsideration and withdrawal of the traversed rejections, entry of the amendments, and an early notice of allowance.

Respectfully submitted,

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²¹ *In re Fine*, 837 F.2d 1071, 1076 (Fed. Cir. 1988).

AMENDED CLAIMS

MARKED-UP VERSION

1. A device for storing a trailer hitch apparatus at a predetermined storage location, having a male trailer hitch mounting member positioned for mating with a female connector, wherein the female connector is mounted to a vehicle, the device comprising:

B1
a mounting portion connected to the predetermined storage location, wherein the predetermined storage location comprises a wall; and
a trailer hitch mounting portion receptacle, connected to the mounting portion.

37. A device for use with a storage compartment for a vehicle having a receptacle, and for use with a trailer hitch mounting apparatus, the mounting apparatus having a male trailer hitch mounting member, the device comprising:

B2
a mounting portion connected to a storage compartment surface, wherein the surface is selected from the group consisting of a wall and a bottom; and
a trailer hitch mounting portion receptacle, connected to the mounting portion.

38. A device as in claim 37 further comprising a block positioned for insertion through a first hole in the receptacle at least a portion of the receptacle and for engagement with the mounting member.

39. A device as in claim 37 further comprising a block positioned for insertion through a first hole and a second hole in the receptacle, wherein parts of the block protrude from the first hole and the second hole, so that the block is positioned for engagement with the mounting member.

~~57. A device as in claim 37 wherein said mounting portion is integrally formed with the storage~~
~~compartment wall.~~

D3

not shown → from the first hole and the second hole, so that the block is positioned [and] for engagement
with the mounting member.

57. (Twice Amended) A device as in claim 37 wherein said mounting portion is integrally formed with [a wall of]the storage compartment wall.

Please cancel claim 58.

1. (Once Amended) A device for storing a trailer hitch apparatus at a predetermined storage location, having a male trailer hitch mounting member positioned for mating with a female connector, wherein the female connector is mounted to a vehicle, the device comprising:

a mounting portion connected to the predetermined storage location, wherein the predetermined storage location comprises a wall; and

a trailer hitch mounting portion receptacle, connected to the mounting portion.

37. (Twice Amended) A device for use with a storage compartment for a vehicle having a receptacle, and for use with a trailer hitch mounting apparatus, the mounting apparatus having a male trailer hitch mounting member, the device comprising:

a mounting portion connected to [the] a storage compartment surface, wherein the surface is selected from the group consisting of a wall and a bottom; and

a trailer hitch mounting portion receptacle, connected to the mounting portion.

38. (Twice Amended) A device as in claim 37 further comprising a block positioned for insertion through a first hole in the receptacle [at least a portion of the receptacle]and for engagement with the mounting member.

39. (Twice Amended) A device as in claim 37 further comprising a block positioned for insertion through a first hole and a second hole in the receptacle, wherein parts of the block protrude